

**REMARKS**

**STATUS OF THE CLAIMS**

In accordance with the foregoing, the specification and claims 1, 3, 5, 7 and 8 have been amended. Claims 1 – 8 are pending and under consideration.

No new matter is being presented, and approval of the amended claims is respectfully requested.

**REJECTION UNDER 35 U.S.C. § 112:**

In the Office Action, at page 2, claims 3 and 5 are rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth therein. This rejection is traversed and reconsideration is requested.

At page 2, the Office Action rejects dependent claims 3 and 5 for insufficient antecedent basis for the limitation of the claim.

Amended dependent claim 3 now recites “a same environment” in line 3. Further, amended dependent claim 5 now recites “the mail software” in line 2. Therefore, claims 3 and 5, as amended, maintain proper antecedent basis.

Therefore it is respectfully submitted that dependent claims 3 and 5, as amended, overcome the rejection. Approval of amended claims 3 and 5 is respectfully requested.

**REJECTION UNDER 35 U.S.C. § 101:**

In the Office Action, at page 2, claims 1 – 6 and 8 are rejected under 35 U.S.C. §101, for the reasons set forth therein. This rejection is traversed and reconsideration is requested.

At page 2, the Office Action rejects claims 1 – 6 and 8 under 35 U.S.C 101 because the claimed invention is directed to a non-statutory subject matter. The examiner refers to MPEP 2106 IV.B.1.(a), which states that data structures not claimed as embodied in computer-readable media are not statutory and cannot be claimed. Further, computer programs claimed as computer listings per se cannot be claimed.

However, the preambles of claims 1 through 6 direct these claims to a method. Further, there is no recital of computer steps as stated by the Examiner. Therefore, claims 1 – 6 constitute patentable subject matter under §101. Thus, the rejections thereof should be withdrawn.

Independent claim 8 is amended herein to recite a computer-readable storage medium storing a program for reading and filing documents. Thus, the rejection is respectfully overcome. Approval of amended claim 8 is respectfully requested.

REJECTION UNDER 35 U.S.C. § 102(b):

In the Office Action, at page 3, claims 1 – 3, 7, and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Brown et al. (US Patent 6,073,137). The rejection is traversed and reconsideration is requested.

Brown et al. (hereinafter “Brown”) discloses a method for updating and displaying that is carried out between an e-mail client 37 and a remote mail server 49. (See Brown, 6: 25-32). Further, Brown, discloses the local version of the folder configuration is created in “Microsoft Outlook,” which provides a system of organizing messages. (See Brown, 5:1-9).

In contrast, amended independent claims 1, 7, and 8 recite creating the same folder configuration in a file system that reads documents by use of a scanner and files the documents on the basis of the obtained information. Therefore, an advantage of the embodiments of the present invention is to enable automatic creation of filing folders, without requiring a user to create filing folders, before an operation of reading paper information (documents) by use of a scanner and filing them. (As support, see for example paragraph [0005] of the present application).

The method disclosed by Brown is capable of merely updating and displaying, which is carried out by two different types of email software, and does not teach or even suggest creating a folder configuration in a file system that reads documents by use of a scanner and files the documents on the basis of obtained information. Therefore, it is respectfully submitted that amended independent claims 1, 7 and 8 patentably distinguish over the prior art. Consequently it is further submitted that dependant claims 2 and 3 also patentably distinguish over the prior art.

REJECTION UNDER 35 U.S.C. § 102(e):

In the Office Action, at page 7, claims 1 and 5 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hendricks (US Pre-Grant Publication 2003/0033271). The rejection is traversed and reconsideration is requested.

Hendricks discloses a transfer of folders from user A mail file 22 to user B mail file 24, merely provides a method that is carried out between two different types of mail software. (See Hendricks, Fig. 5 and Fig. 6).

In contrast, amended claim 1, recites creating the same folder configuration in a file system that reads documents by use of a scanner and files the documents on the basis of the obtained information. Therefore, embodiments of the present invention provide a filing operation in which a computer is connected to, for example, a scanner, and the computer causes file management software to read documents by using the scanner and filing the documents accordingly, without requiring a user to create filing folders. (As support, see for example paragraphs [0005] and [0007] of the present application).

Hendricks does not teach or even suggest creating a folder configuration in a file system that reads documents by use of a scanner and files the documents on the basis of obtained information. Therefore, it is respectfully submitted that the amended independent claim 1 patentably distinguishes over the prior art. Consequently, it is further submitted that dependent claim 5 also patentably distinguish over the prior art.

REJECTION UNDER 35 U.S.C. § 103 (a):

In the Office Action, at page 8, claim 4 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hendricks (US Pre-Grant Publication 2003/0033271) in view of Sykes (US Pre-Grant Publication 2002/0129108). The rejection is traversed and reconsideration is requested.

As noted above, independent claim 1 patentably distinguishes over Hendricks. Claim 4 depends from independent claim 1 and, therefore, it is respectfully submitted that claim 4 also patentably distinguishes over Hendricks.

At page 9, the Office Action acknowledges that Hendricks fails to teach or suggest, "wherein when a file is stored when a file is stored in a folder in the file system" and relies upon Sykes to teach this feature. Sykes, however, fails to cure the deficiencies of Hendricks set forth above. Thus, it is respectfully submitted that claim 4 patentably distinguishes over the prior art.

REJECTION UNDER 35 U.S.C. § 103 (a):

In the Office Action, at page 10, claim 6 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hendricks (US Pre-Grant Publication 2003/0033271) in view of Johnson et al. (US Patent 6,248,996). The rejection is traversed and reconsideration is requested.

As noted above, independent claim 1 patentably distinguishes over Hendricks. Claim 6 depends from independent claim 1 and, therefore, it is respectfully submitted that claim 6 also patentably distinguishes over Hendricks.

At page 10, the Office Action acknowledges that Hendricks fails to teach or suggest, "wherein image data read by use of scanner are simultaneously stored in the two or more storage units" and relies upon Johnson et al. to teach this feature. Johnson et al., however, fails to cure the deficiencies of Hendricks set forth above. Thus, it is respectfully submitted that dependent claim 6 patentably distinguishes over the prior art.

#### CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

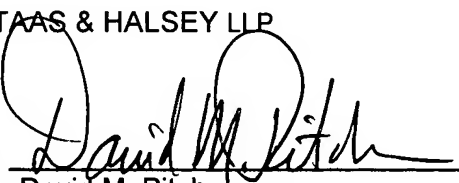
Respectfully submitted,

STAAS & HALSEY LLP

Date:

May 24, 2006

By:

  
David M. Pitcher  
Registration No. 25,908

1201 New York Avenue, NW, 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501